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EXAMINER

KYLE, CHARLES R

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/516,949

Applicant(s)

KUITE ET AL.

Examiner

Charles R Kyle

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 15 recites the limitation "the customer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 8-14 and 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Davis et al* in view of <sup>*Gustin CDK*</sup> ~~*Kelly*~~ *et al*.

**Concerning Claim 1**, *Davis* discloses the invention substantially as claimed, including in a system for enabling an issuing authority to distribute monetary value to a plurality of patrons (Summary of the Invention), the elements of:

At least one smart card associated with each patron of a plurality of patrons, the at least one smart card having a serial number (Col. 1, line 55) and means for storing information (Col. 1, lines 45-54);

A central computer controlled by the issuing authority and having applications for processing monetary information, including monetary value associated with each patron (Abstract, lines 22-29; Col. 25, line 56 to Col. 28, line 57);

A monetary storage device connected to the central computer for storing monetary information (Prior cite and Fig. 1, and related text);

An entry means for updating monetary information to the monetary storage device (Fig. 2, ele. 52 Col. 2, lines 15-43);

An express vending machine having a bi-directional electronic connection to the central computer (Col. 2, lines 1-15) for accepting a transfer of at least a portion of the monetary value to the at least one smart card (Col. 25, line 56 to Col. 28, line 57) and having a user interface for each patron to request the benefits (Fig. 2, ele. 52 Col. 2, lines 15-43). Read/write mechanisms are inherent in smart card technology.

*Davis* does not specifically disclose that the monetary values are expressed as the benefits of Applicants' invention. *Gustin et al* discloses the use of a smart card and associated technologies to distribute benefits like those in Applicants' invention at Col. 2, lines 36-56. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of *Davis* to process benefits as disclosed in *Gustin* because this would have avoided the problems associated with cash and food stamp transactions set forth in the Background of the Invention. See Col. 2, line 36 to Col. Col. 3, line 56.

**As to Claim 2,** *Davis* discloses an intranet as an ATM network at Col. 3, lines 45-60.

**With respect to Claim 3**, see the discussion of inherency in Claim 1 above.

**With respect to Claim 4**, *Davis* discloses a web server operating over the Internet for inputting benefits information at Col. 23, line 58 to Col. 25, line 2.

**Concerning Claim 5**, see the discussion of Claims 1 and 4 above.

**With respect to Claims 8 and 9**, *Gustin* discloses smart card distribution of welfare benefits and purchasing food at Col. 2, lines 37-56.

**With respect to Claims 10 and 11**, *Davis* discloses vending machine account maintenance at Col. 9, lines 29-48, Col. 5, lines 39-54 and Fig. 3, at least. Consolidation of data for centralized account maintenance and report generation was inherent to financial matters, (e.g., bank statements).

**Concerning Claim 12**, *Davis* discloses plural accounts on a smart card at Col. 1, lines 54-58 and account loading at Col. 25, line 3 to Col. 28, line 57.

**With respect to Claims 13-14**, *Davis* discloses a private employer “customer” liable to an issuing authority as a merchant/service provider at Figs. 10-11 and related text.

**As to Claim 16**, see the discussion of Claims 1 and 11. See also *Davis* at Col. 9, lines 29-47.

**As to Claim 17 and 18**, see the discussion of Claims 16 and 3 and *Davis* at Col. 9, lines 29-47 where a server tracks benefits.

**As to Claim 19**, see the discussion of Claim 16 and *Davis* at Summary of the Invention.

**With respect to Claim 20**, it would have been obvious to verify a sequence number because this would have aided in fraud prevention. Such a process is functionally equivalent to old and well known “velocity checking”.

**Claims 6, 7 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Davis et al* and *Gustin et al* and further in view of *Kelly et al*.

**As to Claims 6 and 7**, *Davis* and *Gustin* disclose the invention substantially as claimed, including distribution of benefits using a smart card. They do not specifically disclose that the benefit is issued by a transit authority for transit fares and parking fees. *Kelly* discloses these features at Col. 1, line 63 to Col. 2, line 23.

**As to Claim 15**, see the discussion of Claim 12 and *Gustin* discloses a public employer, government, at Col. 2, lines 36-56.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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August 11, 2003